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EXAMINER

HUYNH, SON P

ART UNIT

PAPER NUMBER

2611

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6

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/110,667

Applicant(s)

BOYLAN III ET AL.

Examiner

Son P Huynh

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 July 1998.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-74 is/are pending in the application.
- 4a) Of the above claim(s) 65-74 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-64 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1 - 64, drawn to a method and system for transmitting the local advertisements to user television equipment, classified in class 725, subclass 36.
- II. Claims 65 -74, drawn to a system and method for enforcing an advertisements usage policy at the television distribution facility, classified in class 725, subclass 93.

2. The inventions are distinct, each from the other because of the following reasons:

3. Inventions II and I are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as enforcing usage policy for using software. See MPEP § 806.05(d).

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

5. During a telephone conversation with Andrew VanCoute (register # 48506), on 03/26/2002 a provisional election was made without traverse to prosecute the invention of Group I, claims 1 - 64. Affirmation of this election must be made by applicant in replying to this Office action. Claims 65 – 74 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. Claims 1 – 5, 13-15, 24-28, 36-38, 47-52, 55-60 are rejected under 35 U.S.C. 102(e) as being anticipated by Carr (US 6,209,129).

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Regarding claim 1, Carr discloses a system in which local advertisements are distributed to user television equipment comprising:

means for distributing the local advertisements to the user television equipment 22; and

means for displaying the local advertisements with the interactive television program guide (see figure 1 and col. 4, lines 62 – 67)

Regarding claim 2, Carr discloses the means for distributing the local advertisements further comprises means for transmitting local advertisements to subscriber at television 22 (see col. 2, lines 1-5).

Regarding claim 3, Carr discloses the means for distributing the local advertisements further comprises data transmission equipment configured to transmit the local information to the television distribution facility as part of a global data stream (see col. 5, lines 6-10).

Regarding claim 4, Carr discloses the data transmission facility further comprises data transmission equipment configured to transmit the local information to the television distribution facility as part of a global data stream that contains global advertisements (see col. 5, lines 11-15).

Regarding claim 5, Carr discloses the data transmission distribution further comprises:

data transmission equipment configured to transmit the local information to the television distribution facility as part of a global data stream, wherein the television distribution facility further comprises television distribution equipment configured to transmit the local information from the television distribution facility to the user television equipment (see col. 5, lines 16-24)

Regarding claim 13, Carr discloses the means for distributing the local advertisement further comprising:

means for transmitting a global advertisements which is included in the global data stream at a television distribution facility;

means for providing local advertisements to the television distribution facility; and

means for transmitting global advertisements and the local advertisements from television distribution facility to the user television equipment (see col. 1, lines 46-57, col. 2, lines 27-38, and col. 5, lines 1-24).

Regarding claim 14, Carr discloses means for distributing the local advertisements as discussed in the rejection of claim 13. Carr further discloses providing users with program guide information (see col. 2, lines 39-45). Inherently, the program guide information is transmitted from the data distribution facility to the television distribution facility, and then to the user equipment.

Regarding claim 15, Carr discloses program guide data and global advertisements are stored at the data transmission facility 14 (see col. 2, lines 15 – 26), and wherein the means for distributing the local advertisements further comprises:

means for transmitting the program guide data and global advertisements from the data transmission facility to a television distribution facility as discussed in the rejection of claim 14;

means for providing local advertisements at the television distribution facility (see col. 5, lines 6-10);

means for transmitting the program guide data, the global advertisements, and the local advertisements to the user television equipment as discussed in the rejection of claims 13 and 14.

Regarding claim 18, Carr discloses a system as discussed in the rejection of claim 1. Carr further discloses displaying local information automatically by cycling global information and local information (see abstract, lines 5-7). Inherently, means for displaying global advertisements and means for cycling the display of the global advertisements and the local advertisements are included in the system.

Regarding claim 20, the elements being claimed are analyzed as discussed in part of the rejection of claim 18. Inherently, means for displaying global advertisements

with the interactive television program guide for displaying global advertisements with the interactive television program guide.

Regarding claim 21, Carr discloses displaying a program listings region with the interactive television program guide (see figure 2). Inherently, means for displaying a program listings region is included in the system.

Regarding claim 22, Carr discloses means for displaying global advertisements with the interactive television program guide and means for displaying a program listings region as discussed in the rejection of claims 18 and 21 respectively.

Regarding claim 23, Carr discloses  
means for transmitting global advertisements and program guide information to a television distribution facility;  
means for providing local advertisements at the television distribution facility;  
means for transmitting the program guide information, the global advertisements, and local advertisements from the television distribution facility to the user television equipment (see col. 1, lines 46 – 57, col. 2, lines 16-38 and col. 5, lines 1-24). Carr further discloses means for displaying the global advertisements with the interactive television program guide; and means for displaying a program listings region containing the program guide information with the interactive television program guide as discussed in the rejection of claim 22 (also see figure 2).



Regarding claim 41, the method elements being claimed correspond to the system elements being claimed in claim 18 and are analyzed with respect to the rejection of claim 18.

Regarding claims 43-46, the method elements being claimed correspond to the system elements being claimed in claims 20 - 23 and are analyzed with respect to the rejection of claims 20 - 23.

Regarding claims 24-28, the method elements being claimed correspond to the system elements being claimed in claims 1-5 and are analyzed with respect to the rejection of claims 1-5.

Regarding claims 36-38, the method elements being claimed correspond to the system elements being claimed in claims 13-15 and are analyzed with respect to the rejection of claims 13-15.

Regarding claim 47, Carr discloses a system comprising:  
means for distributing the advertisements to the user television equipment; and  
means for displaying advertisements with interactive television program guide as discussed in the rejection of claim 1 (also see figure 2). Carr further discloses the upper portion of a passive program guide display may be used to display advertising video

and associated text descriptions. The content of the text descriptions may be targeted toward particular regions (see col. 1, lines 19-28). As a result, television 22 displays only some of the advertisements with interactive television program guide based on the content of the advertisements for a particular region.

Regarding claim 48, Carr discloses the system further comprising means for providing the advertisements with content tags indicating the content of the advertisements (see col. 6, lines 15-18).

Regarding claim 49, Carr discloses a system further comprising: means for providing the advertisements with content tags indicating the content of the advertisements; and television distribution configured to display only those advertisements with desired content tags (see col. 6, lines 20-24).

Regarding claim 50, Carr further discloses means to select blocking criteria that are used to determine which of the advertisements are displayed (see col. 6, lines 25-29).

Regarding claim 51, Carr discloses means (back office) for distributing advertisements with content tags (see col. 6, lines 13-15).

Regarding claim 52, Carr discloses means configured to select blocking criteria that are used to determine which of the advertisements are displayed and television display configured to display only those advertisements with desired content tags (see col. 6, lines 23-28). Inherently, the system comprising means for blocking advertisements with undesired content tags.

Regarding claims 55-60, the method elements being claimed correspond to the system elements being claimed in claims 47-52 and are analyzed as discussed with respect to the rejection of claims 47 – 52.

8. Claims 6 – 8, 12, 29-31 and 35 are rejected under 35 U.S.C. 102(e) as being anticipated by Berezowski (US 6,075,551).

Regarding claim 6, Berezowski discloses a system in which local advertisements are distributed to user television equipment on which an interactive television program guide is implemented, comprising:

means for distributing the local advertisements to the user television equipment;  
and

means (TV unit 24) for displaying the local advertisements with the interactive television program guide (see fig. 3).

Berezowski further discloses means (main facility 10) for transmitting a global data stream to television distribution facility 20;

means (local promotion unit 28) for inserting the local advertisements into the global data stream at the television distribution facility 20; and

means for transmitting the local advertisements from the television distribution facility to the user television equipment (TV unit 24) as part of the global data stream (see figure 3 and col. 5, line 9 – col. 6, line 30).

Regarding claim 7, Berezowski discloses means for distributing the local advertisements further comprises:

means for transmitting a global data stream containing global advertisements to a television distribution facility (see col. 5, lines 9-17);

means for inserting the local advertisements into the global data stream at television distribution facility; and

means for transmitting the local advertisements from the television distribution facility to the user television equipment as part of the global data stream (see col. 5, lines 9- col. 6, lines 29).

Regarding claim 8, Berezowski discloses means for distributing the local advertisements further comprises:

means for transmitting a global data stream containing global advertisements to a television distribution facility (see col. 5, lines 9-17);

means for inserting the local advertisements into the global data stream by overwriting the global advertisements at television distribution facility; and

means for transmitting the local advertisements from the television distribution facility to the user television equipment as part of the global data stream (see col. 5, lines 9- col. 6, lines 29).

Regarding claim 12, Berezowski discloses

means for transmitting a global data stream containing global advertisements to a television distribution facility as discussed in the rejection of claim 7;

means for transmitting the global data stream from the television distribution facility to the user television equipment; and

means for transmitting the local advertisements from the television distribution facility to the user television equipment as a separate data stream from the global data stream (see fig. 5).

Regarding claims 29-31, the method elements being claimed correspond to the system elements being claimed in claims 6-8 and are analyzed with respect to the rejection of claims 6-8.

Regarding claims 35, the method elements being claimed correspond to the system elements being claimed in claim 12 and are analyzed with respect to the rejection of claim 12.

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 9-11, 32-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berezowski (US 6,075,551).

Regarding claim 9, Berezowski discloses system as discussed in the rejection of claim 6. However, Berezowski fails to disclose the global data stream containing bandwidth reserved for local advertisements to a television distribution facility; and means for inserting the local advertisements into the global data stream in the reserved bandwidth at the distribution facility. Official Notice is taken that using a reserved bandwidth for local advertisement in a global data stream is well known in the art to avoid interfering while global stream is transmitted to the television distribution facility. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Berezowski with a well-known technique of providing a bandwidth reserved for local advertisements in order to avoid interfering while the global stream is transmitted to the television distribution facility.

Regarding claim 10, Berezowski discloses system as discussed in the rejection of claim 6. However, Berezowski fails to disclose the global data stream containing slot reserved for local advertisements to a television distribution facility; and means for inserting the local advertisements into the global data stream in the reserved slot at the distribution facility. Official Notice is taken that using a reserved slot for local advertisement in a global data stream is well known in the art for allowing local operator to insert local advertisements at the television distribution facility. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Berezowski with a well-known technique of providing a slot reserved for local advertisements in order to allow local operator to insert local advertisements in the global data stream.

Regarding claim 11, the system element being claimed correspond to the combination of system elements being claimed in claims 8 and 9 and are analyzed as discussed in the rejection of claims 8 and 9.

Regarding claims 32-34, the method elements being claimed correspond to the system elements being claimed in claims 9-11 and are analyzed with respect to the rejection of claims 9-11.

11. Claims 16 - 17, 19, 39-40, 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carr (US 6,209,129).

Regarding claim 16, Carr discloses a system as discussed in the rejection of claim 1. Carr further discloses displaying global advertisement with the interactive television program guide. However, Carr fails to disclose means for displaying global advertisement that may be selected by a user and means for displaying corresponding local advertisements with content related to the content of the global advertisement whenever the user selects the global advertisements. Official Notice is taken that means for displaying global advertisement that may be selected by a user and means for displaying corresponding local advertisements with content related to the content of the global advertisement whenever the user selects the global advertisements are well known in the art for allowing user select a desired local advertisements with content related to global advertisements. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Carr by a well known technique of providing means for displaying global advertisement that may be selected by a user and means for displaying corresponding local advertisements with content related to the content of the global advertisement whenever the user selects the global advertisements in order to allow user selects a desired local advertisements with content related to global advertisements.

Regarding claim 17, Carr discloses a system as discussed in the rejection of claim 16. However, Carr fails to discloses means for displaying a corresponding full-screen local advertisement whenever the user selects the global advertisement. Official



Notice is taken that providing means for displaying a corresponding full-screen local advertisement whenever the user selects the global advertisement for a detail view of the local advertisements is well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art to modify Carr with a well-known technique of providing a means for displaying a corresponding full-screen local advertisement whenever the user selects the global advertisement in order to give user a detail view of the local advertisements.

Regarding claim 19, Carr discloses a system as discussed in the rejection of claim 1. Carr further discloses the local information may be displayed automatically by cycling global information and local information (see abstract, lines 5-7). However, Carr fails to disclose means for displaying global banner advertisement with the interactive program guide information; and means for cycling the displaying of the global banner advertisements and the local advertisements. Official Notice is taken that means for displaying global banner advertisement with the interactive program guide information and means for cycling the displaying of the global banner advertisements and the local advertisements are well known in the art to give user a clear view of the advertisements on the screen. Therefore, it would have been obvious to one of ordinary skill in the art by the time the invention was made to modify Carr with a well-known technique of providing means for displaying global banner advertisement with the interactive program guide information and means for cycling the displaying of the global banner

advertisements and the local advertisements in the system in order to give user a clear view of the advertisements on the screen.

Regarding claims 39-40, the method elements being claimed correspond to the system elements being claimed in claims 39-40 and are analyzed with respect to the rejection of claims 39-40.

Regarding claim 42, the method elements being claimed correspond to the system elements being claimed in claim 42 and are analyzed with respect to the rejection of claim 42.

12. Claims 53-54, 61-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carr (US 6,209,129) and in view of Novak (US 4,750,213).

Regarding claim 53, Carr discloses a system as discussed in the rejection of claim 47. However, Carr fails to disclose the system comprising means for displaying information in place of those advertisements that are not displayed based on their content.

Novak discloses a system for editing unwanted content from transmitted broadcast signal and displaying the desired signal on the screen (see col. 3, lines 15-60 and col. 7, line 51 – col. 8, line 11). Therefore, it would have been obvious to one of

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ordinary skill in the art to modify Carr by providing a edit system as taught by Novak in order to display a desired information in place of the unwanted advertisement.

Regarding claim 54, Carr discloses a system as discussed in the rejection of claim 47. However, Carr fails to disclose the system comprising means for displaying a back up advertisement in place of those advertisements that are not displayed based on their content.

Novak discloses a system for editing unwanted content from transmitted broadcast signal and displaying the desired signal on the screen (see col. 3, lines 15-60 and col. 7, line 51 – col. 8, line 11). Therefore, it would have been obvious to one of ordinary skill in the art to modify Carr by providing a edit system as taught by Novak in order avoid displaying the advertisements to unexpected viewers.

Regarding claims 61-62, the method elements being claimed correspond to the system elements being claimed in claims 53-54 and are analyzed as discussed with respect to the rejection of claims 53-54.

13. Claims 63-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carr (US 6,209,129) and in view of Banker (US 5,357,276).

Regarding claim 63, Carr discloses a system as discussed in the rejection of claims 1 and 3. However, Carr fails to disclose means for time – shifting at least some of the advertisements with the television distribution facility; and means for displaying the time-shifted advertisements with the interactive television program guide.

Banker discloses time shifting feature in the near video on demand and displaying the time-shifted program with the interactive television program guide (see figures 8 and 10). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Carr by providing means for time-shifting and means for displaying the time-shifted program on the display in order to provide an efficient advertising and give user an accurate information about the program.

Regarding claim 64, the method elements being claimed correspond to the system elements being claimed in claim 63 and are analyzed as discussed with respect to the rejection of claim 63.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Son P Huynh whose telephone number is 703-305-1889. The examiner can normally be reached on 8:00-5:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on 703-305-4380. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the customer service office whose telephone number is 703-306-0377.



ANDREW FAILE  
SUPERVISORY PATENT EXAMINER  
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Son P. Huynh  
March 26, 2002